

REMARKS

In an office Action dated 8 March 2007 and a final Office Action dated 11 July 2006, the Examiner rejects claims 1, 5-7, 11-13, 17-21, and 25-30 (all pending claims). In response to the Office Action, Applicants traverse the rejections. Claims 1, 5-7, 11-13, 17-21, and 25-30 remain pending in the application. In light of the following arguments, Applicants respectfully request that this application be allowed.

The Examiner rejects claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,201, 791 B1 issued to Bournas (Bournas) in view of U. S Patent Number 7,010,295 B1 issued to Zerlan (Zerlan) and U.S. Patent Number 6,363,056 B1 issued to Beigi et al. (Beigi). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id. The Examiner has failed to provide evidence of each and every claimed element of claim 1.

Amended claim 1 recites “establishing a routing path for a session to be tested wherein said routing path is a static IP route;” and “counting, by a packet count unit at a second end of said route, received packets at the packet count unit.” The Examiner has also not provided a teaching of counting, by the counting unit, received packets at the packet count unit at the second end of the static IP path. Bournas does not teach this limitation. Instead Bournas, uses acknowledge statements received at the sending

node to determine the number of packets received at the second or client end. See generally, Abstract. See also Col. 6, lines 43-Col. 7, line 8. Specifically, Bournas states When N test packets have been transmitted, step 512 initiates a Retransmission Timer to a value that is much greater than the expected time to receive an acknowledgement for the last test packets. If the timer expires before all of the acknowledgments are received, then an entry is made to the program of 700...” This clearly shows that Bournas does the counting at the sending node and not at the receiving node at the second end as recited in claim 1. In claim 1, the counting unit in the second node does the counting. Thus, eliminating the possibility of the acknowledgment being dropped and therefore giving an inaccurate count of the packets actually received at the second end of the path. There is a notable difference between the items being counted in claim 1 and in Bournas. Bournas counts **ACK packets received at the first end** and claim 1 recite counting **the packets received at the second**. While the counting of these two items may give you comparable results (received packets) and may give similar results. The fact is that the teaching of counting one item i.e. ACK packets does not teach counting a second item i.e. received packets. Unless the examiner has evidence that ACK packets and received packets are the same item, the Examiner cannot maintain that Bournas teaches counting packets received by a counting unit at a second end. Thus, Applicants respectfully request that the rejection of claim 1 be removed and amended claim 1 be allowed.

Beigi also does not teach the counting of packets received at a second end. In stead Beigi teaches that an ingress access points sends a probe packet every nth packet. See Col. 5, line 59-col. 6, line 3. An egress router at the second end receives, identifies and removes the probe packets from the data stream. See Col. 6, line s 4-5. The probe packets are then analyzed. The egress may also count the probe packets received to

determine the total packets received. See Col. 6, lines 6-12. Beigi does not count all of the received packets. Instead, only the probe packet sent in the data stream during regular transmissions are counted and used to generate estimates of bandwidth. Thus, this does not the counting of all of the packets received at a second end during a test. Thus, Beigi does not teach claim 1.

Zerlan also does not teach the counting of packets received at a second end of a static IP route. Instead, Zerlan is concerned about the use of remote device connected to a test host to test communication links over a wireless network. See Abstract. See Also Col. 1, line 64- col. 2, line 27. Applicants have read the entirety of Zerlan and found no reference to packet counting whatsoever. Thus, Zerlan does not teach the counting of packets received at a second end as recited in claim 1.

Since none of the cited references teach counting packets received at a second end of a static IP connection, the combination of the references does not teach the counting of packets at a second end. Thus, Applicants respectfully request the rejection be removed and claim 1 be allowed.

Furthermore, even if the combination teaches all of the claimed limitations, the Examiner has failed to provide evidence of a proper motivation to combine the references. The Examiner has provided no motivation to do so as required by case law and the MPEP. See MPEP §2143. The Examiner is reminded that for a combination to be proper the proposed modification or combination cannot change the principle mode of operation of reference. See MPEP §2143.01 See also In re Ratti, 270 F2d. 810 (CCPA 1959). The Examiner is also reminded that just because all of the elements are individually known in the art does not establish prima facie obviousness without an objective reason to combine the references.

In the office action, the Examiner asserts that the motivation to combine the references is to “determine the network characteristic between two end points.” The Examiner offers no evidence of such a motivation. This is a mere assertion and unless the Examiner can provide evidence of such a motivation in the cited references or elsewhere in the art, the Examiner must remove the rejection and allow claim 1.

Furthermore, this rejection is obvious impermissible hindsight engineering of claim 1. Applicants understand and appreciate that some hindsight is also used in forming a rejection. However, the current rejection is a clear example of when impermissible hindsight has been used. In a prior office action, the Examiner had rejected claim 1 over Bournas. When Applicant traversed the claim and pointed out that Bournas did not teach each and every limitation of claim 1, the Examiner went out and found art that had nothing whatsoever to do with the testing of network and added the art to Bournas to cobble together a combination read on claim 1. If the combination was so obvious why did it take the Examiner two office actions to find the art. Applicants feel that this is clearly a case of improper hindsight engineering and thus the rejection must be removed.

For the above reasons, Applicants respectfully request the rejection of claim 1 be removed and claim 1 be allowed.

Claims 5-6 are dependent upon amended claim 1. Thus, claims 5-6 are allowable for the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 5-6 be removed and claims 5-6 be allowed.

Amended claim 7 recites a program storage device that stores instructions for providing the method of amended claim 1. Thus, amended claim 7 is allowable for at

least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 7 be removed and amended claim 7 be allowed.

Claims 11-12 are dependent upon amended claim 7. Thus, claims 11-12 are allowable for the same reasons as amended claim 7. Therefore, Applicants respectfully request that the rejections of claims 11-12 be removed and claims 11-12 be allowed.

Amended claim 13 recites an apparatus for performing the method of amended claim 1. Thus, amended claim 13 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 13 be removed and amended claim 13 be allowed.

Claims 17-18 are dependent upon amended claim 13. Thus, claims are allowable for the same reasons as amended claim 13. Therefore, Applicants respectfully request that the rejections of claims 17-18 be removed and claims 17-18 be allowed.

Amended claim 19 recites a system that provides the method of amended claim 1. Thus, amended claim 19 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 19 be removed and amended claim 19 be allowed.

Claims 20-21 and 25-30 are dependent upon amended claim 19. Thus, claims 20-21 and 25-30 are allowable for the same reasons as amended claim 19. Therefore, Applicants respectfully request that the rejections of claims 20-21 and 25-30 be removed and claims 20-21 and 25-30 be allowed.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
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Dated: April 11, 2007

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